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REMARKS

Claims 1-20, all the claims pending in the application, stand rejected on prior art grounds.

Claims 8-13 stand rejected upon informalities. Also, the drawings are objected. Claims 1, 4-6, 8-14, and 17-19 are amended herein. Moreover, the specification is amended. Applicants respectfully traverse these rejections based on the following discussion.

I. The Objections to the Drawings

The drawings are objected to as failing to comply with 37 C.F.R. §1.84(p)(5) because they include the following reference characters not mentioned in the description: Items 9 and 21 on Figure 1. Accordingly, the specification has been amended (paragraphs [0020] and [0022] on pages 7-8) to include reference to items 9 and 21 from Figure 1. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objections.

II. The 35 U.S.C. 112, Second Paragraph Rejection

Claims 8-13 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, and more particularly for not reciting any structural elements. Accordingly, claims 8-13 have been amended to recite the structural elements for the computer system. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

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III. The Prior Art Rejections

Claims 1-3, 8-9 and 14-16 stand rejected under 35 U.S.C. §102(e) as being anticipated by Chin et al. (U.S. Publication No. 2002/0120561), hereinafter referred to as "Chin". Claims 4, 10 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chin, and further in view of Michael Fabey, "Brazil Cracks Down", Journal of Commerce, 1998, hereinafter referred to as "Fabey". Claims 5-7, 11-13 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chin and Fabey, and further in view of Turner et al., "Introduction to Industrial and Systems Engineering", hereinafter referred to as "Turner". Applicants respectfully traverse these rejections based on the following discussion.

However, the claimed invention, as provided in amended independent claims 1, 8, and 14 contain features, which are patentably distinguishable from the prior art references of record. Specifically, claims 1 and 14 provide, in part, "...compiling a daily input of supplier invoice data into a weekly statistical sample of supplier invoices, wherein said statistical sample comprises a sampling size greater than a sampling size used in United States Customs Service audits ... selectively comparing said first value with said second value" and claim 8 provides, in part, "...a sampling generator adapted to compile a daily input of supplier invoice data into a weekly statistical sample of supplier invoices, wherein said statistical sample comprises a sampling size greater than a sampling size used in United States Customs Service audits ... an input data management system adapted to selectively compare said first value with said second value."

These features are neither taught nor suggested in the prior art of record. In fact, pages 5-6 of the Office Action admit that neither Chin nor Fabey teaches a "selective statistical sample," but uses Turner to disclose this. However, Turner does not teach having a sampling size greater

than a sampling size used in United States Customs Service audits” as recited in the Applicants’ claims. In fact, this is a non-obvious extension of the purported combination of Chin, Fabey, and Turner because typically one chooses a sample size to be less than the size of a standard. Conversely, the Applicants are choosing a sample size to be greater than the standard. In other words, one of ordinary skill in the art would likely choose a sample size to be less than the size used in United States Customs Service audits (i.e., referred to above as the “standard”), which is contrary to the Applicants’ claimed invention.

Insofar as references may be combined to teach a particular invention, and the proposed combination of Chin, Fabey, and Turner, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined. However, there is nothing in each of the references that suggests such a motivation to combine as suggested in the Office Action. In fact, had such a motivation been anticipated in any of the prior art references, then surely some discussion regarding alternative embodiments or manners of combination would have been suggested or at least inferred in any of the prior art references. In fact, no suggestion for combination is provided in any of the prior art references.

As evidence for the above, the Applicants note that Chin and Fabey are non-analogous art. Also, the Applicants’ claimed invention and Fabey are non-analogous art. First, Chin is most concerned with providing online access to U.S. customs information and Fabey deals with a Brazilian customs. Conversely, the Applicants’ claimed invention deals with U.S. customs information and the means for determining whether declared values match invoiced values. Indeed, such a combination is unobvious to one of ordinary skill in the art.

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In In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: “[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination.” There is nothing in the prior art that refers to a suggestion or desirability of making the proposed combination. Accordingly, the rejection under 35 U.S.C. §103(a) is prima facie defective.

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicants’ novel claimed invention. Moreover, there is nothing in the prior art references themselves, namely Chin, Fabey, and Turner, which suggests a motivation to combine elements from each reference in a manner consistent with the suggestion by the Office Action. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as “compiling a daily input of supplier invoice data into a weekly statistical sample of supplier invoices, wherein said statistical sample comprises a sampling size greater than a sampling size used in United States Customs Service audits” and “selectively comparing said first value with said second value.” As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to

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allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Chin fail to disclose all of the elements of the claims of the Applicants' claimed invention, but also, if combined with Fabey and Turner, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Chin, alone, or in combination with Fabey and Turner teaches a structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

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The Office Action provides its own conclusions as to what are the motivations to combine. However, the Applicants respectfully submit that these conclusions are based on impermissible hindsight analysis and that one of ordinary skill in the art would not be so motivated to make such a combination or partake in such analysis. Certainly, the motivation and reasons to combine expressed in the Office Action reflect one having extraordinary skill in the art and the luxury of hindsight.

In view of the foregoing, the Applicants respectfully submit that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 8, and 14 and as such, claims 1, 8, and 14 are patentable over Chin, alone, or in combination with Fabey and Turner. Further, dependent claims 2-7, 9-13, and 15-20 are similarly patentable over Chin, alone, or in combination with Fabey and Turner, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

IV. Formal Matters and Conclusion

With respect to the objections to the drawings and the rejections to the claims, the specification and claims have been amended, above, to overcome these objections and rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the

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objections to the drawings and the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1-20, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 50-0510.

Respectfully submitted,

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